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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,627	07/16/2007	Tetsuji Yoshimura	063012	4866
38834 7590 11/26/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
SERGENT, RABON A				
ART UNIT		PAPER NUMBER		
1796				
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11/26/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/594,627

**Applicant(s)**

YOSHIMURA ET AL.

**Examiner**

Rabon Sergeant

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 7, 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 9/28/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)  
3) ☐ Information Disclosure Statement(s) (PTO/CDC)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what requirements or limitations are conveyed by “medically suitable”.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 8, 10-16, and 18-20 of copending Application No. 10/499,331 in view of Hiraishi et al. ('266) or Nakamura et al. (US 2003/0225239) or Sparer et al. (US 2004/0033251) or Felt et al. (US 2005/0060022). The co-pending application claims medical adhesives having the same properties and derived from the same reactants as those instantly claimed; however, the claims of the co-pending application fail to recite applicants' instantly claimed phenolic radical scavenger. However, the position is taken that the use of phenolic antioxidants that correspond to applicants' claimed phenolic radical scavenger within polyurethanes, suitable for use within medical applications, was known at the time of invention. This position is supported by the teachings of the secondary references. See Example 1 within Hiraishi et al. See paragraphs [0168], [0175], and [0177]-[0180] within Nakamura et al. See paragraph [0121] within Sparer et al. See Table 1 within Felt et al. Since it has been held that it is *prima facie* obvious to use a known component for its art recognized function, the position is taken that it would have been obvious to incorporate known phenolic antioxidants within the urethane based composition of the co-pending application, so as to obtain an improved and further stabilized adhesive composition. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

This is a provisional obviousness-type double patenting rejection.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/051952 in view of Hiraishi et al. ('266) or Nakamura et al. (US 2003/0225239) or Sparer et al. (US 2004/0033251) or Felt et al. (US 2005/0060022).

WO 03/051952 discloses medical adhesives having the same properties and derived from the same reactants as those instantly claimed; however, while WO 03/051952 discloses that stabilizers may be incorporated within the adhesive composition, the reference fails to disclose applicants' instantly claimed phenolic radical scavenger. However, the position is taken that the use of phenolic antioxidants that correspond to applicants' claimed phenolic radical scavenger within polyurethanes, suitable for use within medical applications, was known at the time of invention. This position is supported by the teachings of the secondary references. See Example 1 within Hiraishi et al. See paragraphs [0168], [0175], and [0177]-[0180] within Nakamura et al.

See paragraph [0121] within Sparer et al. See Table 1 within Felt et al. Since it has been held that it is *prima facie* obvious to use a known component for its art recognized function, the position is taken that it would have been obvious to incorporate known phenolic antioxidants within the urethane based composition of the primary reference, so as to obtain an improved and further stabilized adhesive composition. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

6. It is noted that GB 2399345 is the English language equivalent of WO 03/051952; therefore, applicants are directed to this document for a full description of the adhesive composition within WO 03/051952. Specifically, applicants are directed to pages 9, 11, 28, 40, and 47 of the GB reference.

7. Applicants have argued that their showings of unexpected results rebut the *prima facie* case of obviousness. In response, the examiner has considered applicants' examples within the specification and the examples within applicants' 37 CFR 1.132 declaration, filed December 26, 2007; however, the showings are insufficient to rebut the *prima facie* case of obviousness, because the examples are not commensurate in scope with the claims. It has been held that the claims must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. It has further been held that a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. Applicants' examples are limited to specific polyisocyanates, specific polyol compounds having specific characteristics, and specific phenolic radical scavengers used in specific amounts; however, applicants' claims are not so limited. Accordingly, since the scope of the claims is far broader than the scope of the examples and showings, applicants have failed to provide adequate

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showings of unexpected results for the full scope of the claims. Accordingly, the nonstatutory obviousness-type double patenting rejection and the prior art rejection have been maintained for the reasons of record.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

R. Sergent  
November 24, 2008